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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/876,276	06/16/1997	JAY SHORT	09010/020001	4852

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SAN DIEGO, CA 92121-2189

EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 12/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/876,276

Applicant(s)

SHORT ET AL.

Examiner

David J. Steadman

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 October 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-21, 35 and 37 is/are rejected.
- 7) ☒ Claim(s) 22-34, 36 and 38-46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Application Status***

Claims 19-46 are pending in the application.

Amendment to claims 19 and 30 and addition of claim 46 in Paper No. 30, filed 08 October 2002, is acknowledged.

Receipt of a Terminal Disclaimer in Paper No. 31 is acknowledged.

Applicants' arguments filed in Paper No. 30 have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

The text of those sections of Title 35 U.S. Code not included in the instant action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

1. The rejection of claims 19-21, 35, and 37 under 35 U.S.C. 102(b) as being anticipated by Abeijon et al. (Proc Natl Acad Sci USA 93:5963-5968, 1993) is maintained. Applicants argue Abeijon et al. does not teach the claimed method. Applicants argue Abeijon does not teach preparation of a library of naturally-occurring genes or gene pathways in which each clone may contain any type of DNA and wherein the DNA in each clone is obtained from an organism from a mixed population of organisms. It is noted that the method of claim 19 is not so limited to a step of preparing a library of naturally-occurring genes or gene pathways in which each clone may contain any type of DNA and wherein the DNA in each clone is obtained from an organism from a mixed population of organisms. Instead, claim 19 is limited to "a library containing a plurality of clones containing DNA from at least one organism". This limitation is taught by Abeijon et al. who teaches a *K. lactis* mutant strain that is transformed with a genomic library of DNA from wild-type *K. lactis*. Contrary to applicants' assertion, Abeijon clearly anticipates the claimed method by teaching a method for screening transformants that bind a fluorescent lectin as follows: contacting *K. lactis* mutant cells transformed with a wild-type *K. lactis* genomic library with fluorescein

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isothiocyanate conjugated to *Griffonia simplicifolia* lectin and screening for cells that bind terminal N-acetylglucosamine using a fluorescence activated cell sorter (see Paper No. 28 for cited quotations).

Therefore, Abeijon clearly anticipates claims 19-21, 35, and 37.

### ***Double Patenting***

2. In view of applicants submission of a terminal disclaimer, rejection of claims 19-45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-11, 15, 16, 18, 19, and 21-23 of U.S. Patent No. 6,174,673 is withdrawn.

### ***Conclusion***

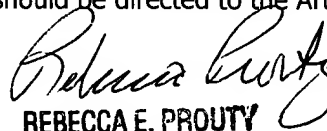
3. Claims 19-21, 35, and 37 are rejected.
4. Claims 22-34, 36, and 38-46 are objected to as being dependent upon a rejected base claim.
5. No claim is condition for allowance.

**THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:30 am to 2:00 pm and from 3:30 pm to 5:30 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Group is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.  
Patent Examiner  
Art Unit 1652

  
**REBECCA E. PROUTY**  
**PRIMARY EXAMINER**  
**GROUP 1800**  
1652